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### REMARKS

#### Additional References

Applicant has submitted in a co-filed Information Disclosure Statement (IDS) the prior art that was found by the USPTO in the examination of a co-pending, related, patent application, having the first named inventor Curry, entitled "Integration of audio or video program with application program," filed on February 5, 2002, and assigned serial number 09/683,706 [attorney docket no. 1049.001US1]. Applicant requests the consideration of this additional prior art.

#### Claim Rejections Under 35 USC 102

Claims 1-24 have been rejected under 35 USC 102(b) as being anticipated by Budge (6,564,248). Applicant vigorously but respectfully submits that these claims are not anticipated by Budge. Furthermore, Applicant strongly asserts that the Examiner's position as to these claims being anticipated by Budge would not stand on appeal. Applicant now discusses each of the claims rejected under 35 USC 102 in order.

#### *Rejection of Claim 1 Under 35 USC 102*

Claim 1 is an independent claim including a network, a first client, and a second client. Importantly, the first client has "a first email messaging program installed thereon *on which a composing user composes a message and records media*, the first email messaging program *sending the message to a receiving user over the network*". (Emphasis added) That is, the first email messaging program is the program on which a composing user both composes a message and records media, and is the program that sends the message. Similarly, the second client has "a second email messaging program installed thereon on which the receiving user *receives the message over the network, the second email messaging program playing back the media upon the user viewing the message*". (Emphasis added) That is, the second email messaging program is the program that receives the message, and plays back the media upon the receiving user

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viewing the message. Applicant submits that Budge does not disclose at least the emphasized limitations of claim 1.

Applicant submits that Budge does not disclose the limitation of a first email messaging program "on which a composing user composes a message and records media" and which "send[s] the message over the network" nor the limitation of a second email messaging program "receiv[ing] the message over the network" and "playing back the media upon the user viewing the message", such that Budge does not anticipate the invention of claim 1. Budge teaches and discloses an e-mail client 270 that is separate from both a video e-mail recorder 210 and a video e-mail player 220, as depicted in FIG. 2B. The e-mail messaging program of Budge, the e-mail client 270, neither records media nor plays back the media that has been recorded. Rather, the recorder 210 and the player 220 are used for these purposes. Therefore, Budge does not anticipate the claimed invention of claim 1, because in claim 1 the first e-mail messaging program records media (whereas Budge's does not), and the second e-mail messaging program plays back media (whereas Budge's does not).

Furthermore, the mechanics of the e-mail client 270, the video e-mail recorder 210, and the video e-mail player 220 in Budge are disclosed and taught in such a way that Budge does not anticipate the claimed invention.

The video e-mail recorder 210 receives as inputs video message data . . . . The video e-mail recorder 210 *also executes the Email client 270 and passes the video e-mail file to the Email client 270.*

The video e-mail player [220] *receives as inputs the video message file from the Email client 270 . . . .* The video e-mail player 220 outputs video message data . . . and audio message data . . . .

(Col. 4, ll. 31-49) (Emphasis added) The video e-mail recorder 210 includes a recorder manager that "coordinates the various recorder functions *and interfaces with the Email client software residing on the PC.*" (Col. 5, ll. 3-5) The video e-mail player 220 "reads a video e-mail file 410, *originating from the resident Email client.*" (Col. 5, ll. 11-12)

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The video e-mail recorder 210 in Budge thus records media, and then executes a separate program, the e-mail client 270, passing the recorded mail to the e-mail client 270. Whereas the invention of claim 1 is limited to a *single* program, an e-mail messaging program, *both recording media and sending a message* (including the media) over the network, in Budge these functionalities are divided into two separate programs: the video-email recorder 210 and the e-mail client 270. Furthermore, whereas the invention of claim 1 is limited to a *single* program, an e-mail messaging program, *both receiving the message over the network and playing back the media*, in Budge these functionalities are divided into two separate programs: the e-mail client 270 and the video-email player 220.

Therefore, Budge does not anticipate claim 1. It divides media recording and message sending functionality into two different programs, a video e-mail recorder and an e-mail client, whereas claim 1 is specifically limited to such functionality being encased within a single e-mail messaging program. Furthermore, Budge divides message receiving and media playback functionality into two different programs, an e-mail client and a video e-mail player, whereas claim 1 is specifically limited to such functionality being encased within a single e-mail messaging program. Budge does not render claim 1 unpatentable.

Applicant further notes and submits that Budge is not modifiable so that its media-recording and message-sending functionality is present within a single e-mail messaging program and so that its media-playback and message-receiving functionality is present within a single e-mail messaging program, such that a *prima facie* case of obviousness under 35 USC 103 cannot be proffered. First, there is no motivation or suggestion within the prior art to modify Budge so that a single e-mail messaging program includes both media-recording and message-sending functionality or both media-playback and message-receiving functionality. Budge presents one workable and operable way to enable media to be sent over e-mail, such that there is no motivation to modify the manner by which it works to render the invention of claim 1 obvious.

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More significantly, modifying Budge so that a single e-mail messaging program includes both media-playback and message-receiving functionality renders Budge unsuitable for its intended stated purpose.

A significant feature of the video e-mail system according to the present invention is that a video e-mail message is optionally sent with an attached executable video e-mail player . . . . As a result, the receiving sub-system 4 need only include conventional PC hardware and peripherals *and execute conventional software, such as widely available Email client programs, in order to receive and playback received video e-mail messages.*

(Col. 4, ll. 13-21) (Emphasis added) That is, the point in Budge is having an e-mail messaging program that is separate from a media-playback program means that *any widely available* e-mail messaging program can be used to receive a video e-mail message, because a *separate* media-playback program (preferably attached to the message) is used to actually playback the media. However, if Budge were modified so that its e-mail messaging program accomplished both message-receiving and media-playback functionality, then Budge could not be used with *any widely available* e-mail messaging program, but rather only e-mail messaging programs that had media-playback functionality. This renders Budge unsuitable for its stated intended purpose. For at least these two reasons, then, Budge is not properly modified to render the invention of claim 1 obviousness, such that claim 1 is patentable under US 35 103 over Budge.

#### *Rejection of Claim 2 Under 35 USC 102*

Claim 2 is a dependent claim depending from claim 1. As such, it is patentable for at least the reasons that have been described in accordance with claim 1. Claim 2 adds an element to the system of claim 1, a "streaming media server." The first email messaging program "upload[s] the media to the streaming media server upon the message being sent to the receiving user over the network," whereas the second email messaging program "download[s] the media from the streaming media server over the network upon the receiving user viewing the message." That is,

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the media is uploaded to the streaming media server by the composing user's email messaging program, and then downloaded from the streaming media server by the receiving user's email messaging program when the receiving user views the message. Applicant submits that Budge does not disclose this added limitation of claim 2, such that claim 2 is independently patentable irrespective of the patentability of claim 1.

To assist the Examiner in understanding why Budge does not disclose a streaming media server, Applicant has submitted definitions of "streaming audio," "streaming server," and "streaming video" from the *Computer Desktop Encyclopedia* in the co-filed Form PTO-1449. Streaming video is defined as "one-way video transmission over a data network . . . Unlike movie files . . . that are played after they are downloaded, streaming video is played within a few seconds of requesting it, and the data is not stored permanently in the computer." Streaming audio is similarly defined. A streaming server is "a dedicated computer system delivering streaming media or to a streaming service within a Web or application server."

The Examiner refers to FIG. 5 and column 5, line 12, through column 6, line 54, of Budge as teaching or disclosing a streaming media server, as to which claim 2 is limited. However, neither FIG. 5 nor column 5, line 12, through column 6, line 54, recite *any* sort of server, let alone a streaming media server. Applicant has further reviewed Budge in detail, and cannot find *any* reference to a streaming media server within. Therefore, Budge does not anticipate the invention of claim 2, because it fails to teach or disclose a streaming media server.

Indeed, Budge's video e-mail recorder does not stream media to a server, but rather saves the media to the user's computer, in contradistinction to the definition of streaming video noted above. Budge discloses that a "virtual VCR allows the user to record *and save* both audio and video . . . to the user's PC," where the virtual VCR is provided as a part of the "GUI for the preferred embodiment of the video e-mail recorder." (Col. 5, ll. 59-64) (Emphasis added) A video e-mail message file, upon the pressing of a save button, "is *stored* to the hard disk." (Col. 6, ll. 7-9) (Emphasis added) For a received video e-mail message, the user presses a load

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button, allowing the user "to select which *stored* message to watch." (Col. 6, ll. 21-22) The storage of the media within Budge, both at the composing user's computer and at the receiving user's computer, further indicates that Budge does not teach or disclose streaming media, providing reason as to why Budge does not teach or disclose a streaming media server, as to which claim 2 is limited. Therefore, Budge does not anticipate claim 2.

*Rejection of Claims 3, 11, and 14 Under 35 USC 102*

Claims 3, 11, and 14 are dependent claims depending from independent claims 1 and 8. As such, they are patentable for at least the same reasons that have been described in relation to claim 1, and that are described later in the office action response in relation to claim 8. Applicant therefore submits that these claims are not anticipated by Budge.

*Rejection of Claim 4 Under 35 USC 102*

Claim 4 is a dependent claim depending from independent claim 1. As such, it is patentable for at least the same reasons that have been described in relation to claim 1. Applicant therefore submits that this claim is not anticipated by Budge.

*Rejection of Claim 5 Under 35 USC 102*

Claim 5 is a dependent claim depending from independent claim 1. As such, it is patentable for at least the same reasons that have been described in relation to claim 1. Applicant therefore submits that this claim is not anticipated by Budge.

*Rejection of Claims 6 and 7 Under 35 USC 102*

Claims 6 and 7 are dependent claims depending from independent claim 1. As such, they are patentable for at least the same reasons that have been described in relation to claim 1. Applicant therefore submits that these claims are also not anticipated by Budge.

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Furthermore, Applicant submits that claim 7 is independently patentable over Budge, irrespective of the patentability of claim 1. Claim 7 recites that the media may include streaming audio or streaming video. However, as discussed in relation to claim 2 above, Budge does not teach or disclose any type of streaming media or streaming media server. Therefore, claim 7 is not anticipated by Budge.

*Rejection of Claim 8 Under 35 USC 102*

Claim 8 is an independent claim including a network mechanism and an email messaging program. Importantly, the email messaging program has at least “a composing capability for a user to compose a message and *record media associated with the message to send to another user* over the network via the networking mechanism.” (Emphasis added) Applicant submits that Budge does not disclose at least the emphasized limitation of claim 8.

Budge does not employ an email messaging program that has the capability for a user to compose a message and record media associated with a message that is sent to another user over a network, as has been discussed in association with claim 1. Budge discloses a video e-mail recorder that records the media, and a separate e-mail client that sends the message with the media to the other user. That is, Budge uses two separate programs to perform the functionality inventively performed by the invention of claim 8 in a single email messaging program. An email messaging program having the capability to which claim 8 is limited – to compose a message, to record media, and to send the message with the media – is not disclosed by Budge in this respect. Budge does not, therefore, anticipate claim 8.

*Rejection of Claim 9 Under 35 USC 102*

Claim 9 is a dependent claim depending from independent claim 8. As such, it is patentable for at least the same reasons that have been described in relation to claim 8. Applicant therefore submits that this claim is not anticipated by Budge.

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*Rejection of Claim 10 Under 35 USC 102*

Claim 10 is a dependent claim depending from claim 8. As such, it is patentable for at least the reasons that have been described in accordance with claim 8. Claim 10 limits the composing capability of the email messaging program to “upload[ing] the media to a streaming media server communicatively coupled to the network over the network via the networking mechanism upon the message being sent to the other user over the network via the networking mechanism.” Applicant submits that Budge does not disclose this added limitation of claim 10, such that claim 10 is independently patentable over Budge, irrespective of the patentability of claim 8.

Budge does not employ an email messaging program that uploads media to a streaming media server, as has been discussed in association with claim 2. There is no streaming media server within Budge, and Budge’s system does not employ streaming media in any way. Budge does not, therefore, anticipate claim 10.

*Rejection of Claims 12 and 13 Under 35 USC 102*

Claims 12 and 13 are dependent claims depending from claim 8. As such, they are patentable for at least the reasons that have been described in accordance with claim 8. Claim 12 adds an additional limitation to the email messaging program of claim 8, such that the email messaging program also has “a playback capability for the user to view messages received from other users over the network via the networking mechanism and play back received media associated with the messages received.” Claim 13 limits the playback capability of the email messaging program of claim 12 to “download[ing] the media associated with one of the messages received from the streaming media server over the network via the networking mechanism upon the user viewing the one of the messages received.” Applicant submits that Budge does not

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disclose these added limitations of claims 12 and 13, such that claims 12 and 13 are independently patentable over Budge, irrespective of the patentability of claim 8.

With respect to claim 12, Budge does not employ an email messaging program that has the capability to play back media associated with a message that is received from another user over a network, as has been discussed in association with claim 1. Budge discloses a video e-mail player that plays back media, and a separate e-mail client that receives a message including the media that is then played back by the video e-mail player. That is, Budge uses two separate programs to perform the functionality inventively performed by the invention of claim 12 in a single email messaging program. An email messaging program having the capability to which claim 12 is limited – to receive a message and to playback the media associated with the message – is not disclosed by Budge in this respect. Budge does not, therefore, anticipate claim 12.

With respect to claim 13, Budge does not disclose an email messaging program that downloads media from a streaming media server, as has been discussed in association with claim 2. There is no streaming media server within Budge, and Budge's system does not employ streaming media in any way. Budge does not, therefore, anticipate claim 13.

#### *Rejection of Claim 15 Under 35 USC 102*

Claim 15 is a dependent claim depending from independent claim 8. As such, it is patentable for at least the same reasons that have been described in relation to claim 8. Applicant therefore submits that this claim is not anticipated by Budge.

#### *Rejection of Claims 16 and 17 Under 35 USC 102*

Claims 16 and 17 are dependent claims depending from claim 8. As such, they are patentable for at least the same reasons that have been described in relation to claim 8. Applicant therefore submits that these claims are also not anticipated by Budge. With respect to claim 17, Budge specifically does not disclose any type of streaming media or streaming media server, and

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claim 17 is thus patentable for at least the same reasons that claim 7 is patentable, irrespective of the base independent claim 8 from which claim 17 depends.

*Rejection of Claim 18 Under 35 USC 102*

Claim 18 is an independent claim in which a method has “an email messaging program” “saving a message entered by a user,” “recording media associated with the message,” “uploading the media to a streaming media server over a network,” and “sending the message over the network.” That is, the email messaging program performs all of these functions. Applicant submits that Budge does not disclose a method having such an email messaging program, as to which claim 18 is limited.

Budge does not use a single email messaging program to both record media associated with a message and to send the message (including the media) to another user over a network, as has been discussed in association with claim 1. Budge instead employs a separate video e-mail recorder program to record the media, and a separate e-mail client program to send a message including the media to the other user. Furthermore, Budge does not use an email messaging program that uploads media to a streaming media server, as has been discussed in association with claim 2. Budge does not disclose or employ streaming media or a streaming media server in any way. Therefore, Budge does not anticipate claim 18.

*Rejection of Claim 19 Under 35 USC 102*

Claim 19 is a dependent claim depending from claim 18. As such, it is patentable for at least the same reasons that have been described in relation to claim 18. Claim 19 also has the email messaging program of the method of claim 18 “receiving a second message over the network,” and “in response to a user requesting the email messaging program to display the second message,” “displaying the second message,” “downloading second media associated with the message from the streaming media server over the network,” and “playing back the second

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media." That is, the email messaging program performs all of these functions. Applicant submits that Budge does not disclose a method having such an email messaging program, as to which claim 19 is limited.

Budge does not use a single email messaging program to playback media associated with a message that has been received over a network, as has been discussed in association with claim 1. Budge instead employs a separate e-mail client program to receive the message including the media, and a separate video e-mail player program to playback the media. Furthermore, Budge does not use an email messaging program that downloads media from a streaming media server, as has been discussed in association with claim 2. Budge does not disclose or employ streaming media or a streaming media server in any way. Budge does not anticipate claim 19, irrespective of the patentability of claim 18 from which it depends.

*Rejection of Claim 20 Under 35 USC 102*

Claim 20 is an independent claim. Claim 20 is a method in which an "an email messaging program" performs the following functionality: "saving a message entered by a user," "recording media associated with the message by the email messaging program," "attaching the media to the message", and "sending the message over a network". The email messaging program thus performs all of these functions, in which media is attached to an email message. Applicant submits that Budge does not disclose a method having such an email messaging program, as to which claim 20 is limited.

Budge does not use a single email messaging program to both record media associated with a message and to send the message (including the media) to another user over a network, as has been discussed in association with claim 1. Budge instead employs a separate video e-mail recorder program to record the media, and a separate e-mail client program to send a message including the media to the other user. Therefore, Budge does not anticipate claim 20.

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*Rejection of Claim 21 Under 35 USC 102*

Claim 21 is a dependent claim depending from claim 20. Therefore, claim 21 is patentable for at least the same reasons that claim 20 is patentable. Claim 21 is a method in which the email messaging program of claim 20 further performs the following functionality: "receiving a second message having attached thereto second media over the network"; and, "in response to the user requesting the email messaging program to display the second message," "displaying the second message" and "playing back the second media by the email messaging program." The email messaging program thus performs all of these functions. Applicant submits that Budge does not disclose a method having such an email messaging program, as to which claim 21 is limited.

Budge does not use a single email messaging program to playback media associated with a message that has been received over a network, as has been discussed in association with claim 1. Budge instead employs a separate e-mail client program to receive the message including the media, and a separate video e-mail player program to playback the media. Budge does not anticipate claim 21, irrespective of the patentability of claim 20 from which it depends.

*Rejection of Claim 22 Under 35 USC 102*

Claim 22 is an independent claim in which a computer-readable medium has instructions stored on the medium "for an email messaging program." It is, therefore, the *email messaging program* that includes the "means for composing a first message by a first user and for recording first media associated with the first message to send to a second user over a network" and the "means for viewing a second message received from the second user over the network by the first user, and for playing back send media associated with the second message." Applicant submits that Budge does not disclose an email messaging program that has such means.

Applicant notes that claim 22 is thus limited in its preamble to "an email messaging program" that has the two means elements. Applicant notes that the preamble to a claim is to be accorded "the import that the claim as a whole suggests for it." (MPEP, sec. 2111.02) More

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specifically, “[i]f the claim preamble, when read in the context of the entire claim, . . . ‘is necessary to give life meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” (*Id.*)

The MPEP additionally cites *Kropa v. Robie*, 187 F.2d 150 (CCPA 1951), as providing an example that is particularly apt in the context of the preambles of claims 1, 2, 4, 6, 9, and 10.

A preamble reciting “An abrasive article” was deemed essential to point out the invention defined by claims . . . . The court stated that “it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an ‘abrasive article.’ . . . .” Therefore, the preamble served to further define the structure of the article produced.

(MPEP, sec. 2111.02) Similarly, it is only by the phrase “an email messaging program” that it can be known that the subject matter defined by claim 22 is comprised as a computer-readable medium having instructions stored thereon for “an email messaging program.”

Budge, however, does not disclose an email messaging program that can compose an email message and record media associated with the message, and that can receive an email message and playback media associated with the message, as has been discussed in association with claim 1. Budge employs three separate programs: an e-mail client 270 to send and receive messages (including media), a video e-mail recorder 210 to record the media, and a video e-mail player 220 to playback the media. The media is thus not recorded or played back by an email messaging program in Budge. Budge, therefore, does not anticipate claim 22.

#### *Rejection of Claim 23 Under 35 USC 102*

Claim 23 is a dependent claim depending from claim 22. As such, it is patentable for at least the reasons that have been described in accordance with claim 22. Claim 23 adds further limitations to the means elements of the email messaging program of claim 22. The means for composing and for recording further “uploads the first media to a streaming media server communicatively coupled to the network over the network upon the first message being sent to

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the second user over the network." The means for viewing and for playing back further "downloads the second media from the streaming media server over the network upon the first user viewing the second message." Applicant submits that Budge does not disclose these added limitations of claim 23.

Budge does not employ an email messaging program that uploads media to or downloads media from a streaming media server, as has been discussed in association with claim 2. There is no media streaming server disclosed by Budge, and Budge does not disclose any type of streaming media. Budge does not, therefore, anticipate claim 23, irrespective of the patentability of claim 22 from which it depends.

*Rejection of Claim 24 Under 35 USC 102*

Claim 24 is a dependent claim depending from independent claim 22. Therefore, claim 24 is patentable for at least the same reasons that claim 22 is. Therefore, claim 24 is also not anticipated by Budge.

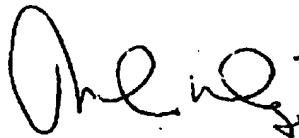
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Conclusion

Applicant has made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Michael Dryja, Applicant's Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,



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